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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/726,573

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Peter A. Alsberg

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02/27/2007

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EXAMINER

KARMIS, STEFANOS

ART UNIT

PAPER NUMBER

3691

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/726,573

Applicant(s)

ALSBERG ET AL.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

1. The following communication is in response to Applicant's Appeal Brief filed 07 September 2006.

Response to Appeal Brief

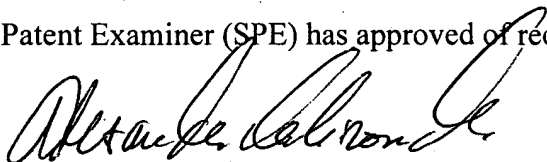
2. In view of the Appeal Brief filed on 07 September 2006, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



Alex Kalinowski

SPE Art Unit 3691.

Status of Claims

3. Claims 1-24 are currently pending. Claims 25-87 have been cancelled.

Claim Rejections - 35 USC § 101

4. Claims 1-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to claims 1-24, the Examiner finds these claims to lack a tangible result. In order to be a tangible result, the process must produce a real-world result. The limitations of claims 1 and 16, including “associating each advantage offer” and “changing the association of at least one associated advantaged offer” do not produce a real-world result because such limitations could be encompassed as thoughts. Therefore, claims 1 and 16 do not produce a tangible result and are considered to be abstract. Dependent claims 2-15 and 17-24 fail to create a tangible result and therefore also stand rejected under 35 U.S.C. 101.

This rejection could be overcome by including language directed towards outputting/displaying the more favorable offers, storing the more favorable offers or something similar.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 8, 9, 16 and 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Alon et al. (hereinafter Alon) U.S. Patent 7,146,330.

Regarding claim 1, Alon discloses a computer-implemented method for clearing offers, which specify conditions for acceptance, and the method comprising:

Receiving a plurality of advantaged offers (column 5, lines 6-30 and column 6, lines 9-23);

Associating each advantaged offer with one or more available most-favorable disadvantaged offers, wherein the conditions of acceptance of each advantaged offer are met by each disadvantaged offer that has been associated with the advantaged offer (column 5, lines 31-43; Examiner notes where group members are notified of the best bids; and column 6, lines 24-33)

Changing the association of at least one associated advantaged offer to a newly available disadvantaged offer that offers more favorable terms than a currently associated disadvantaged offer, when the newly available disadvantaged offer is received and meets the conditions of acceptance of the associated advantaged offer (column 5, lines 44-54; Examiner notes the iteration with lower bids which are more favorable).

Claim 2, wherein the advantaged and disadvantaged offers are associated with a pool and a corresponding pool close event (column 4, lines 16-23 and column 6, lines 34-37).

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Claim 8, wherein determining which disadvantaged offers have more favorable specifications comprises: comparing price specifications (column 5, lines 44-54).

Claim 9, wherein comparing the price specification comprises comparing constant prices (column 5, lines 31-54).

Regarding claim 16, Alon discloses a computer-implemented method for clearing offers, which specify conditions for acceptance, and the method comprising:

Receiving a description of transaction to be offered in the marketplace (column 6, lines 9-23);

Expanding the description of transactions to be offered in the marketplace into at least one offer, with specified conditions of acceptance (column 6, lines 9-23); and

Generating a set of post events based on the at least one offer in a manner to cause the transactions to be offered in a marketplace in which a marketplace method for processing offers is used, and the marketplace method comprising:

Receiving a plurality of advantaged offers (column 5, lines 6-30 and column 6, lines 9-23);

Associating each advantaged offer with one or more available most-favorable disadvantaged offers, wherein the conditions of acceptance of each advantaged offer are met by each disadvantaged offer that has been associated with the advantaged offer (column 5, lines 31-43: Examiner notes where group members are notified of the best bids; and column 6, lines 24-33)

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Changing the association of at least one associated advantaged offer to a newly available disadvantaged offer that offers more favorable terms than a currently associated disadvantaged offer, when the newly available disadvantaged offer is received and meets the conditions of acceptance of the associated advantaged offer (column 5, lines 44-54: Examiner notes the iteration with lower bids which are more favorable).

Claim 21, Alon discloses the events include straddles specifying a straddle limit, which restricts the number of associations, and wherein generating a set of post events further comprises: creating an offer corresponding to one of the descriptions; adding the created offer to any corresponding straddles; and generating a straddle including the created the offer if no corresponding straddles exist (column 4, lines 52-65 and column 6, lines 1-8).

Claim 22, monitoring the marketplace for new opportunities to post an offer corresponding to offers in a posted straddle; and adding an offer corresponding to the new opportunity to the posted straddle (column 5, lines 44-54).

Claim 23, wherein receiving a description of offered transactions further includes: providing a user interface to specify products in the offer (column 5, lines 55-67).

Claim 24, wherein generating a set of post events further includes: generating offers contingent on the occurrence of an event (column 6, lines 11-23).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 3-7, 10-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alon et al. (hereinafter Alon) U.S. Patent 7,146,330 in further view of Goddard U.S. Patent 6,876,983.

Claim 3, Alon teaches specified conditions for acceptance (column 6, lines 9-23). Alon fails to teach applying attributes of one of the advantaged offers to a price function for one of the disadvantaged offers to calculate a price. Goddard teaches a system and method for facilitating aggregate shopping in which attributes are applied to a price function (column 12, lines 1-39). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Alon to include price functions as taught by Goddard

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because it provides a method for the grouped buyers to obtain their preferred product at a desired price.

Claim 4, Goddard further teaches that the price includes all appropriate costs (column 12, lines 47-50 and column 13, lines 5-11).

Claim 5, Goddard further teaches applying a weighting function to the calculated price (column 12, lines 40-46).

Claim 6, Goddard further teaches using as the price function a table in which price ranges correspond to attributes of an advantaged offer (column 13, lines 5-11).

Claim 7, Goddard further teaches using as the price function a computer program capable of defining price based on attributes of an advantaged offer (column 13, line 44 thru column 14, line 22).

Claim 10, Alon fails to teach performing in order or priority the advantaged offers, such priority being determined by the order in which the advantaged offers were received. Goddard teaches matching supply and demand in order of priority (column 11, lines 43-47). It would have been obvious to one of ordinary skill in the art to modify the teachings of Alon and include the priority teachings of Goddard because it provides for an efficient way to match offers when there is an imbalance between supply and demand.

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Claim 11, Alon teaches that the available disadvantaged offers comprise offers that are not already associated with other offers (column 5, lines 44-54).

Claims 12 and 13, Alon teaches specifications such as pool specifications (column 6, lines 9-23). Goddard further teaches a product specification, a quantity specification, a pool specification, and a fragment list; and wherein determining which disadvantaged offers have more favorable specifications includes: examining the product specification, quantity specification, pool specification and fragment list of the offers (column 12, lines 30 thru column 13, line 15).

Claims 14 and 15, Goddard further teaches quantity specifications including minimum quantity and maximum quantity and determining which disadvantage offer has more favorable specifications by examining the minimum or maximum quantities (column 12, lines 17-30).

Claim 17, Goddard further teaches a stepped-price schedule having price breaks at each price step in the stepped-price schedule, and wherein generating a set of post events includes: generating an uninterruptible sequence of offers, each offer in the sequence corresponding to a price step in the stepped-price schedule, and each offer having a reserve price equal to the price break of the price step (column 12, lines 1-39).

Claim 18, Goddard teaches the transaction is an all-or-none specification having a minimum quantity, and wherein generating a set of post events includes: posting an offer with a

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minimum quantity specification corresponding to the minimum quantity in the all-or-none specification (column 12, lines 1-29 and lines 62-67).

Claim 19, Goddard further teaches that the transactions is a fill-or-kill specification having a minimum quantity, and wherein generating a set of post events includes: posting an offer with a minimum quantity specification corresponding to the minimum quantity in the fill-or-kill specification; and withdrawing the offer if the minimum quantity specification cannot be satisfied (column 12, lines 1-29 and lines 62-67).

Claim 20, Goddard further teaches that the transactions is a fill-and-withdraw specification having a desired quantity, and wherein generating a set of post events includes: posting an offer with a maximum quantity specification corresponding to the desired quantity in the fill-and-withdraw specification; and withdrawing any quantity of the offer not immediately filled (column 12, lines 1-29 and lines 62-67).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

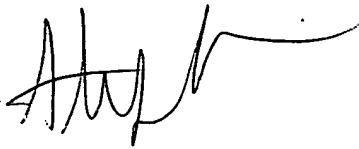
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted

Stefano Karmis

12 February 2007

A handwritten signature in black ink, appearing to read 'Stefano Karmis', with a long horizontal flourish extending to the right.